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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,500	10/15/2003	Kenichiro Tada	041465-5206	6730

55694 7590 05/18/2007  
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EXAMINER

SHIBRU, HELEN

ART UNIT PAPER NUMBER

2621

MAIL DATE DELIVERY MODE

05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/684,500

Applicant(s)

TADA ET AL.

Examiner

HELEN SHIBRU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7 and 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Murabayashi (US PG PUB 2005/0180580 A1).

Regarding claim 1, Murabayashi discloses a data-recording apparatus that records video images comprising a plurality of still images, onto a recording medium and comprising: a maximum-data-amount-detection device for detecting the maximum amount of data of a still image for special reproduction among a plurality of still images (see figs. 2A-C, fig. 3, fig. 330, 32 and paragraphs 0056-0057, 0059, 0060-0061, 0134, 0443, 0468, 0498); and a recording device for recording said detected maximum amount of data onto said recording medium on which said video images are recorded (see figs. 1, 26, 27, and paragraphs 0361 and 0382).

Regarding claim 2, Murabayashi discloses video images are video images that have been compressed according to the MPEG2 (Motion Picture Experts Group 2) method (see paragraph 0052); and wherein said still images for special reproduction are the I (Intra-coded) pictures in said MPEG2 method (see paragraphs 0054, 0383, and 0386).

Regarding claim 3, Murabayashi discloses a data-reproduction apparatus that reproduces said video images that are recorded on the said recording medium by the data-recording apparatus, and converts them into special reproduction images for said special reproduction (see

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rejection of claim 1) and comprising: a reproduction device for reproducing said video images from said recording medium (see fig. 1); a detection device for detecting said recorded maximum data amount from said recording medium (see paragraph 0061); a setting device for setting conversion specification based on said detected maximum data amount when converting said video images to said special-reproduction images (see paragraphs 0386 and 0390); and a conversion device for converting said reproduced video images to said special-reproduction images based on said set conversion specification (see paragraphs 0442, 0452-0460).

Regarding claim 4, Murabayashi discloses conversion specification is memory capacity of a temporary memory device for temporarily storing video images when converting said video images to said special-reproduction images, and the temporary memory device is secured inside a memory device of said data-reproduction apparatus (see paragraphs 0106-0109).

Regarding claim 5, Murabayashi discloses conversion specification is the bandwidth used when outputting said special-reproduction images to the outside after conversion (see paragraphs 0061, 0063, 0118-0119, and 0323).

Claims 6 and 7 are rejected for the same reasons discussed in claims 1 and 3 respectively above.

Claims 12 and 13 are rejected for the same reasons discussed in claims 1 and 2 above respectively.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murabayashi.

Regarding claims 8-9, the limitations in claims 10-11 can be found in claims 1 and 3. However claims 10-11 further require a computer data signal embodied in a carrier wave and causing a computer to detect a maximum data amount and recording the detected amount as claimed in claims 1 and 3. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Murabayashi by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the apparatus claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Regarding claims 10-11, the limitations in claims 10-11 can be found in claims 1 and 3. However claims 10-11 further require a recording medium storing a computer readable program, and causing a computer to detect a maximum data amount and recording the detected amount as claimed in claims 1 and 3. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Murabayashi by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the apparatus claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8, 9, 12, and 13 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. In addition a mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer, and therefore are not statutory. See MPEP 2106.IV.B.1.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329.


The examiner can normally be reached on 8AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru  
May 11, 2007



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